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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

81230.38455

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on November 3, 2005

Signature

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Application Number

10/662,263

Filed

9/15/2003

First Named Inventor

PATRICK H. HAYES

Art Unit

2635

Examiner

Zimmerman, Brian A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number

35,906☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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NOVEMBER 3, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR THE REVIEW REQUEST

In the application claims 1-10 remain pending. Claims 11-19 have been canceled without prejudice.

Pending claims 1-10 stand rejected under 35 U.S.C. § 103 as being rendered obvious by Pariente (WO 9409570) as modified by Renner (5679945).

It is respectfully submitted that the rejection under 35 U.S.C. § 103 must be withdrawn for the reason that the combination of Pariente and Renner fails to present a *prima facie* case of obviousness, i.e., the references, whether considered alone or in combination, fail to include each and every element set forth in the claims and, furthermore, fail to have any disclosure that would suggest the desirability of modifying Pariente to arrive at the invention set forth in the claims. It is additionally submitted that the rejection under 35 U.S.C. § 103 must be withdrawn for the reason that Renner is simply non-analogous art.

In rejecting the claims it was acknowledged that Pariente fails to disclose, teach, or suggest the claimed readable media wherein the readable media has stored thereon access data that is modifiable by the remote control for the purpose of limiting use of code data that is also read from the readable media. It was, however, asserted that Renner teaches an intelligent card reader in which "the card is programmed with limitations such as the number of times the card can be used or having a preprogrammed expiration date." Thus, the Office Action concluded that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an operation limitation to the number of times the Pariente card can be used in order to prevent unauthorized use of the card to protect against unauthorized use."

In response to this rejection of the claims it is respectfully submitted that, when Renner is considered in its entirety, Renner cannot be said to have any disclosure that can be said to suggest the desirability of modifying Pariente to arrive at the invention set forth in the

claims. In this regard, like Pariente, nothing from Renner expressly or inherently describes, teaches, or suggests the desirability of providing a readable media that has stored thereon access data that is modifiable by a reading device, i.e., a remote control, for the purpose of limiting use of other data, i.e., code data, that is also read from the readable media by the reading device as is set forth in the claims.

Turning to Renner, Renner describes a system for limiting access to physical locations wherein the physical locations are under the control of an intelligent card reader (“ICR”). In Renner, the card inserted into the ICR stores nothing more than a static key value (Col. 11, lines 17-22) and once the static key value is read from the card by the ICR, the ICR (and not the “ICR (card)” as alleged by the Examiner) may be programmed to use the read key value to control parking garage gates or other types of entry-inhibiting devices such as safes or file cabinets, to make access contingent on other parameters such as the time of day or day of week, or to control access to a number of times or a preprogrammed expiration date. (Col. 11, lines 30-35). Nothing from Renner, however, discloses, teaches, or suggests, either expressly or inherently, that the ICR functions to modify any data that is stored on the card insertable into the ICR for any purpose, let alone for the purpose of limiting use of other data read from the card by the ICR of which no such other data exists within the system of Renner.

From the foregoing it is respectfully submitted that, even if it is assumed that Renner does disclose that the “ICR (card) can be programmed to make access based on other parameters” as alleged by the Examiner, Renner still fails to disclose, teach, or suggest the desirability of a system in which data stored on a card is modified by a device which reads the card, e.g., a remote control, as is claimed. Similarly, nothing within Renner discloses, teaches, or suggests the desirability of causing the reading device to modify access data stored on a card for the purpose of limiting use of other data read from the card by the

reading device as is claimed. Thus, even if Renner does suggest providing a “limitation to the number of times the Pariente card can be used in order to prevent unauthorized use of the card to protect against unauthorized use” as alleged by the Examiner, Renner nevertheless fails to have any disclosure that can be said to suggest modifying Parienti to provide a limitation to the number of times code data read from the Parienti card can be used by causing the remote control to modify access data that is also stored on the Parienti card as is set forth in the claims.

In sum, since neither Pariente nor Renner disclose, describe, teach, or suggest, either expressly or inherently, a card that has stored thereon both code data and data that is modifiable by the reading device, i.e., remote control, for the purpose of limiting use of the code data that is read from the card by the reading device as is set forth in the claims, the combination of Pariente and Renner cannot be said to establish a *prima facie* case of obviousness. For this reason, it is submitted that the rejection of claims 1-10 must be withdrawn.

It is still further respectfully submitted that Renner, which addresses the problem associated with how to limit access to physical locations, i.e., parking garages, safes, etc., is clearly non-analogous art and, therefore, not suitable for use in determining the obviousness of the invention claimed. In this regard, it is well settled that “in order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). With respect to the first criteria used to determine relevance of a prior art reference it cannot be argued that the programmable card reading lock disclosed within Renner is in the field of

remote controls. This is evidenced by, among other things, the USPTO classifications of Renner as compared to the USPTO classifications of the subject application for patent. With respect to the second criteria used to determine relevance of a prior art reference, it is submitted that the disclosure within Renner would not have commended itself to the inventor's attention in considering the problem the subject invention solves, i.e., the problem solved by the subject invention has nothing to do with using a key to limit access to physical locations via a programmable key accepting lock. Thus, for the reason that Renner is non-analogous art it is respectfully submitted that the rejection of the claims must be withdrawn. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) (Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories and since memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories.)

It is additionally submitted that **a *prima facie* case of obviousness has never been presented for any of dependent claims 2-10.** In this regard, the Examiner has never pointed out where Pariente or Renner discloses, teaches, or suggests code data stored on a readable media that is limited in use by means of access data wherein the code data specifically: 1) functions to add codes to the remote control; 2) functions to allow remote control access to limited-access programming; 3) functions to allow timed access to limited-access programming; 4) functions to allow a predetermined number of accesses to limited-access programming; 5) functions to enable access to a code stored within the remote control; 6) functions to associate command codes within buttons of the remote control; or 7) functions as data representative of a channel line-up of a broadcast service provider. Since the burden of

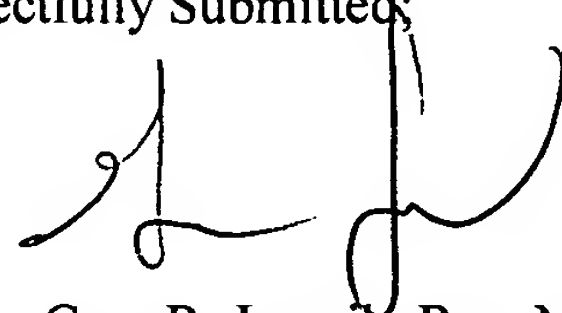
presenting a *prima facie* case of obviousness with respect to claims 2-10 has not been met, the rejection of claims 2-10 must be withdrawn.

CONCLUSION

It is respectfully submitted that claims 1-10 are in condition for allowance.

While it is not believed that any fees are due, the Commissioner authorized to charge any fee deficiency to deposit account number 50-2428.

Respectfully Submitted;



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